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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,724	12/17/1999	TADASHI WATANABE	0020/K-210(K)	1534

7590

12/20/2002

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EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 12/20/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-10

Advisory Action

Application No.

09/466,724

Applicant(s)

WATANABE ET AL.

Examiner

Monique R Jackson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 December 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 10-26.

Claim(s) withdrawn from consideration: 27.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Continuation of Item No. 2. NOTE: The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search, and they are deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. The proposed amendments recite the limitation “then electrodepositing an anionic or cationic electrodeposition paint” however the limitation “an anionic or cationic” would require further consideration and/or search given that the limitation “anionic” was never previously presented in the claims.

Continuation of Item No. 5. NOTE: The Applicant’s arguments filed 12/3/02 have been considered but are not persuasive, in part due to the fact that they are directed to the proposed amendments that have not been entered for the above-recited reasons. With respect to Applicant’s arguments that the electrodeposited metal layer taught by the prior art is not equivalent to the anionic or cationic electrodeposited paint of the instant invention, “which mainly comprises a combination of anionizable or cationizable basic resin and crosslinking agent,” it is noted that the electrodeposited metal layer taught by the prior art does in fact read on the instantly claimed invention wherein the term “electrodeposited paint” is taken in its broadest sense given that the instant disclosure, including the claims, do not define the term “electrodeposited paint” to be limited to one which “mainly comprises a combination of anionizable or cationizable basic resin and crosslinking agent.” With regards to the Applicant’s arguments over Lo, which does not teach a preformed film but instead teaches applying to a non-conductive polymeric component or substrate an electroconductive primer which is conductive when cured into a film on the substrate, it is noted that the “preformed film” limitation is a

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process limitation wherein product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In *re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985.) Therefore, given the final product taught by Lo appears to be the same as the instantly claimed invention though not produced by utilizing a preformed film, the Examiner maintains that the invention taught by Lo reads on the instantly claimed invention. With regards to the obviousness rejections, it appears as if the Applicant is arguing the references separately. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the Applicant attempts to argue unexpected results however it is noted that the alleged unexpected results are not with respect to the teachings of the closest prior art. Hence, the Examiner maintains her position that the instantly claimed invention would have been obvious over the prior art for the reasons recited in the prior office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



mrj
December 19, 2002



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700